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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,804	10/12/2001	Kouji Seino	1448.1016	7763
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER LASTRA, DANIEL	
			ART UNIT 3688	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/974,804

**Applicant(s)**

SEINO, KOUJI

**Examiner**

DANIEL LASTRA

**Art Unit**

3688

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/09/2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 44, 46, 47, 49, 50, 52, 53, 55, 57, 59, 60, 61, 63, 64, 66, 67, 68, 70, 72, 74-76, 78, 79, 81, 82, 84, 85 and 87-95 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 44,46,47,49,50,52,53,55,57,59-61,63,64,66-68,70,72,74-76,78,79,81,82,84,85 and 87-95.

### **DETAILED ACTION**

1. Claims 44, 46, 47, 49, 50, 52, 53, 55, 57, 59, 60, 61, 63, 64, 66, 67, 68, 70, 72, 74-76, 78, 79, 81, 82, 84, 85 and 87-95 have been examined. Application 09/974,804 (METHOD OF AND APPARATUS FOR DISTRIBUTING INFORMATION, AND COMPUTER PRODUCT) has a filing date 10/12/2001 and foreign data 06/28/2001.

### **Response to Amendment**

2. In response to Non Final rejection filed 01/25/2008, the Applicant filed an Amendment on 04/09/2008, which amended claims 44, 50, 57, 64, 72, 79 and cancel claims 48, 54, 56, 62, 69, 71, 77, 83 and 86.

### ***Claim Objections***

3. Claims 49, 55, 63, 70, 78 and 85 are objected to because they are dependent from previously cancel claims. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 44, 46, 47, 49, 57, 59, 60, 61, 63, 72, 74-76, 78, 84, and 87-92 are rejected under 35 U.S.C. 102(e) as being anticipated by Holtz (US 6,760,916).

As per claims 44, 57 and 72, Holtz teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see col 17, lines 30-40 "standard viewer would include a standardized listing of available media selection (e.g. news stories) displayed in a menu format such as media index 1104 in figure 11);

a receiving unit that receives a specified information from the client computer in response to the summary, the specified information specifying which electronic article is selected by a user of the client computer (see col 18, lines 1-10). Holtz teaches that a user would review for example the new stories (i.e. "summary") displayed in the standard listing (e.g. media index 1104 in figure 11) and can request (i.e. "specified information") to review all or a subset of the displayed stories in any order. The user would operate the user's computer to send the request to enhanced media server 115 (see col 18, lines 1-10);

an extracting unit that extracts a plurality of electronic articles from the article database based on the specified information (see col 18, lines 7-12 "media server 115 would interact with IM server 130 to verify the availability and obtain the location of the selected news stories);

a creating unit that creates a homepage based on the electronic articles extracted by the extracting unit and the advertisement extracted by the advertisement extracting unit and an uploading unit that uploads the homepage created by the creating unit to a predetermined website (see col 16, lines 35-65);

an advertisement extracting unit that extracts an advertisement from an advertisement database based on the electronic articles extracted by the extracting unit (see col 35, lines 53-65).

wherein the creating unit recreates the homepage when any one of the electronic articles extracted by the extracting unit and the advertisement extracted by the advertisement extracting unit is updated (see figure 11).

*Wherein for every electronic article, "updated necessary/unnecessary" information items are registered in response to the user's request (see col 32, lines 15-20; col 33, lines 1-7, line 45- col 34, line 6); and*

*Wherein the re-creating of the homepage is performed when the "update necessary/unnecessary" information of the updated information indicates "update necessary" (see col 32, lines 15-20; col 33, lines 1-7, line 45- col 34, line 6).*

As per claims 46, 60 and 75, Holtz teaches:

a number-of-times calculating unit that calculates a first number of times an advertisement is extracted from the advertisement database by the advertisement extracting unit, or a second number of times an advertisement is used for creating the homepage by the creating unit (see col 18, lines 10-55).

As per claims 47, 61 and 76, Holtz teaches:

a website notifying unit that notifies the website to which the homepage is uploaded by the uploading unit to the client computer (see col 32, lines 12-20).

As per claims 49, 63 and 78, Holtz teaches:

a recreation notifying unit that notifies the client computer that a recreation of the homepage has been performed (see col 32, lines 12-20).

As per claims 59 and 74, Holtz teaches:

re-extracting another advertisement from the advertisement database when a display order of the electronic articles is changed at the client computer (see col 34, lines 20-25).

As per claims 87, 89 and 91, Holtz teaches:

wherein a detailed level of the summary is determined by the user in advance (see col 31, lines 25-50).

As per claims 88, 90 and 92, Holtz teaches:

wherein the specified information further specifies whether a homepage is to be created or a electronic mail is to be prepared, and the creating unit creates the homepage when the specified information specifies that a homepage is to be created (see col 32, lines 20-25).

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 50, 52, 53, 55, 64, 66-68, 70, 79, 81-83, 85, and 93-95 are rejected under 35 U.S.C. 102(e) as being anticipated by Holtz (US 6,760,916) in view of Howard (US 2005/0091109) and further in view of Fortenberry (US 6,101,485).

As per claims 50, 64 and 79, Holtz teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see col 17, lines 30-40 "standard viewer would include a standardized listing of available media selection (e.g. news stories) displayed in a menu format such as media index 1104 in figure 11);

a first receiving unit that receives a first specified information from the client computer in response to the summary, the first specified information specifying which electronic article is selected by a user of the client computer (see col 18, lines 1-10). Holtz teaches that a user would review for example the new stories (i.e. "summary") displayed in the standard listing (e.g. media index 1104 in figure 11) and can request (i.e. "specified information") to review all or a subset of the displayed stories in any order. The user would operate the user's computer to send the request to enhanced media server 115 (see col 18, lines 1-10).

a first extracting unit that extracts a plurality of electronic articles from the article database based on the first specified information (see col 18, lines 7-12);



a preparing unit that prepares an electronic mail (see col 32, lines 20-25)

a second extracting unit that extracts a plurality of electronic articles from the article database based on the second specified information (see col 18, lines 1-10);

a creating unit that creates a homepage based on the electronic articles extracted by the second extracting unit and the advertisement extracted by the second advertisement extracting unit (see figure 11); and

an uploading unit that uploads the homepage created by the creating unit to a predetermined website (see figure 11a).

a first advertisement extracting unit that extracts an advertisement from an advertisement database and a second advertisement extracting unit that extracts an advertisement from the advertisement database based on the electronic articles extracted by the first extracting unit and the second extracting unit (see col 4, lines 15-20).

wherein the creating unit recreates the homepage when any one of the electronic articles extracted by the extracting unit and the advertisement extracted by the advertisement extracting unit is updated (see figure 11).

*wherein for every electronic article, "updated necessary/unnecessary" information items are registered in response to the user's request (see col 32, lines 15-20; col 33, lines 1-7, line 45- col 34, line 6); and*

*wherein the re-creating of the homepage is performed when the "update necessary/unnecessary" information of the updated information indicates "update necessary" (see col 32, lines 15-20; col 33, lines 1-7, line 45- col 34, line 6).*

Holtz does not teach that said electronic mail is based on the electronic articles extracted by the first extracting unit and the advertisement extracted by the first advertisement extracting unit and that a second receiving unit that receives a second specification from the client computer in response to the electronic mail prepared by the preparing unit, the second specified information specifying which electronic article is selected by the user of the client computer. However, Howard teaches a system that send emails to users based upon said users' preferences (see abstract) and Fortenberry teaches a system that displays in a website (i.e. shopping cart) items selected by users when said users reply to emails (see figure 1, col 5, lines 30-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Holtz would transmit news and advertisements to users via email, as taught by Howard and would display in a website articles selected by users when said users reply to emails, as it is old and well known to do so, as taught by Fortenberry.

As per claims 52, 67 and 82, Holtz teaches:

a number-of-times calculating unit that calculates a first number of times an advertisement is extracted from the advertisement database by any one of the first advertisement extracting unit and the second advertisement extracting unit, or a second number of times an advertisement is used for any one of preparing the electronic mail by the preparing unit and creating the homepage by the creating unit (see col 18, lines 10-65).

As per claims 53, 68 and 83, Holtz teaches:

a website notifying unit that notifies the website to which homepage is uploaded by the uploading unit to the client computer (see col 32, lines 15-20).

As per claims 55, 70 and 85, Holtz teaches:

a recreation notifying unit that notifies the client computer that a recreation of the homepage has been performed (see col 32, lines 20-25).

As per claims 66 and 81, Holtz teaches:

re-extracting another advertisement from the advertisement database when a display order of the electronic articles is changed at the client computer (see col 34, lines 20-25).

As per claims 93-95, Holtz teaches wherein the second specified information comprises a keyword (see col 17, lines 1-5) but does not teach that said specified information comprises a reply electronic mail. However, Official Notice is taken that it is old and well known in the communication art to reply to email messages. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Holtz would allow readers to reply to emails, as it is old and well known to do so, where said reply emails would contain keywords indicating the stories' topics that said readers would have chosen to be electronically mailed to them, as it is old and well known to search articles using keywords, as taught by Holtz.

### ***Response to Arguments***

6. Applicant's arguments filed 04/09/2008 have been fully considered but they are not persuasive. The Applicant argues that Holtz does not teach the claimed limitation of *wherein for every electronic article, "updated necessary/unnecessary" information items*

*are registered in response to the user's request and wherein the re-creating of the homepage is performed when the "update necessary/unnecessary" information of the updated information indicates "update necessary".* The Examiner answers that Holtz teaches allowing a user to request to receive the most updated version of a new stories and updating a webpage based upon said request (see col 32, lines 15-20; col 33, lines 1-7, line 45- col 34, line 6). Therefore, contrary to Applicant's argument, Holtz teaches Applicant's claimed limitation.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

/DANIEL LASTRA/  
Art Unit 3688  
June 29, 2008